



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/307,485	05/10/1999	STEPHEN CHIN	LNC314/97	4894

20350 7590 10/16/2002

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

PWU, JEFFREY C

ART UNIT PAPER NUMBER

3624

DATE MAILED: 10/16/2002

92

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/307,485

Applicant(s)

CHIN, STEPHEN

Examiner

Jeffrey Pwu

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/7/2002 Appeal Brief.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

Art Unit: 3624

DETAILED ACTION

1. The final rejection of claims 1-25 over **Mersky and Mersky** in view of **Barzilai** is hereby withdrawn in view of applicants' appeal brief filed 8/7/2002. Any inconvenience is regretted.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

3. Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by Novogrod (US 6,367,693)

Novogrod teaches a method of purchasing a money order via the Internet (abstract), comprising the steps of:

providing a money order system (34) capable of generating money orders;

Art Unit: 3624

contacting the money order system via the Internet by a user (35) desiring to purchase a money order in a predefined amount;

transmitting information to the money order system via the Internet required to purchase the money order, the information including user's identification, an intended receiver identification, and financial amount of the money order (col.5, lines 57-60; 654);

generating a money order from the system upon receipt of the transmitted information (670);
sending the generated money order to the intended receiver (512, "dispensing information");and

generating an e-mail message to at least one of the user or intended receiver of the money order that the money has been sent to the intended receiver (col.8, lines 43-48).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novogrod in view of Barzilai et al. (6,012,045).

Novogrod teaches a method of purchasing a money order via the Internet (abstract), comprising the steps of:

providing a money order system (34) capable of generating money orders;
contacting the money order system via the Internet by a user (35) desiring to purchase a money order in a predefined amount;
transmitting information to the money order system via the Internet required to purchase the money order, the information including user's identification, an intended receiver identification, and financial amount of the money order (col.5, lines 57-60; 654);

Art Unit: 3624

generating a money order from the system upon receipt of the transmitted information (670);
sending the generated money order to the intended receiver (512, "dispensing information"); and

generating an e-mail message to at least one of the user or intended receiver of the money order that the money has been sent to the intended receiver (col.8, lines 43-48.)

Novogrod fails to teach an auction transaction which awards a bid to a buyer.

Barzilai is applied for showing that it is conventional to perform online payment from online bidding, sales, and auctions over the Internet (see claims 1, 15 and 20).

In view of Barzilai, it would have been obvious to a person having ordinary skill in the art to use Novogrod's money order system to pay for Barzilai's online purchases (Electronic Fund Transfer) for the purpose of a real-time and 24/7 business transactions and to provide the transferee with a higher degree of confidence that the negotiable instrument can be cashed for the value stated on its face. Furthermore, for a more secure and efficient processing of payments.

Response to Arguments

6. Applicant's arguments with respect to claims 1-25 have been considered but are moot in view of the new ground(s) of rejection.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Jeffrey Pwu, whose telephone number is (703) 308-7835.

Jeffrey Pwu



Oct 12, 2002